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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,160	12/01/2003	Lei Wu	ART-00104.P.1.2	4793
24232	7590	10/05/2006	EXAMINER	
DAVID R PRESTON & ASSOCIATES APC 5850 OBERLIN DRIVE SUITE 300 SAN DIEGO, CA 92121			YANG, NELSON C	
			ART UNIT	PAPER NUMBER
			1641	

DATE MAILED: 10/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/725,160	WU ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Nelson Yang	1641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 23 August 2006.  
 2a) This action is FINAL. 2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 49-68 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 49-68 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. 09/399,299.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 23, 2006 has been entered.

2. Claims 49-68 are currently pending.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 49-68 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claims 49 and 59 recite an electromagnetic chip comprising one or more micro-electromagnetic units on or within or partially within said electromagnetic chip. It is unclear whether the electromagnetic chip is actually just a substrate, or if it also requires one or more micro-electromagnetic units on or within or partially within in order to be considered an electromagnetic chip, or if there are additional undisclosed elements that would render the electromagnetic chip an electromagnetic chip. Further clarification would be appreciated.

6. The remaining claims are indefinite due to their dependence on an indefinite claim.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 49-68 are rejected under 35 U.S.C. 102(e) as being anticipated by Burdon et al. [US 6,572,830].

With respect to claims 49, 59, Burdon et al. teach a device comprising a pair of electromagnets aligned generally perpendicularly to a channel so as to direct magnetic flux into channel (column 26, line 63 – column 27, line 8, fig. 34), wherein the electromagnetic comprises a core defined by stacked vias in layers that have been filled with high permeability material (column 27, lines 9-15), the layers being between 50 to 250 microns thick (column 7, lines 1-6). By applying current to electromagnet 1220 and/or electromagnet 1222 (see fig. 34), magnetic microspheres present in the fluid in channel may be moved around or held in place, as may be desired (column 27, lines 25-43).

9. With respect to claims 50-52, 60-62, Burdon et al. teach that DNA molecules can be attached to magnetic microspheres through the use of chemical reaction surfaces or binding sites (column 20, lines 8-11).

10. With respect to claims 53, 63, Burdon et al. teach that the device can be used for manipulating magnetic particles by attracting the particles to each of the active sources, or to a particular source that is activated (column 27, 27-35), which would be considered magnetophoresis.

11. With respect to claim 54, 64, Burdon et al. teach that the coils may be energized sequentially to move magnetic microspheres, such that one electromagnetic may be turned on and another be turned off and vice versa, to move magnetic microspheres from coil to coil (switching means) (column 27, lines 63-67).

12. With respect to claims 55, 65, Budron et al. teach cores defined by stacked vias in layers (terminal structures) (column 27, lines 8-20).

13. With respect to claims 56, 66, Budron et al. teach that a plurality of cavities (dips) may be formed in the layers of the device (column 23, lines 1-8)

14. With respect to claims 57, 58, 67, 68, The electromagnetic units may be in a substantially horizontal configuration (fig. 35, where the coils are wound around the channel) or vertical configuration (fig. 34, where the electromagnetic units are underneath the channel).

### *Response to Arguments*

15. Applicant's arguments with respect to claims 49-56 have been considered but are moot in view of the new ground(s) of rejection.

### *Conclusion*

16. No claims are allowed.

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17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nelson Yang whose telephone number is (571) 272-0826. The examiner can normally be reached on 8:30-5:00.

18. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long V. Le can be reached on (571)272-0823. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

19. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nelson Yang  
Patent Examiner  
Art Unit 1641

*Long V. Le*  
LONG V. LE 09/22/06  
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